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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/382,457	08/25/99	HARRIS M	P06477US0/DE

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MM91/0417

EXAMINER	
ROBINSON, M	
ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 04/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/382,457	Harris
Examiner	**Group Art Unit**
Mark Robinson	2872

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _1_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-46* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-46* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 2,3,9-13,18,22,23,25,26, drawn to an endoscope/microscope with specifics of the head/beam splitting means, classified in class 359, subclass 368.

II. Claims 4-8,35-41, drawn to an endoscope/microscope further including mounting/scanning specifics, classified in class 359, subclass 368.

III. Claims 14-17,19-21,42,43,45,46, drawn to an endoscope/microscope further including specifics of the light receiving means, classified in class 359, subclass 368.

IV. Claims 27-34, drawn to an endoscope/microscope further including polarization rotating means, classified in class 359, subclass 368.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I,II,III and IV are related as subcombinations disclosed as usable together in a single

combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the claims of invention I evidence that the combination does not rely on the details of inventions II,III or IV for patentability, the claims of invention II evidence that the combination does not rely on the details of inventions I,III or IV for patentability, the claims of invention III evidence that the combination does not rely on the details of inventions I,II or IV for patentability, and the claims of invention IV evidence that the combination does not rely on the details of inventions I,II or III for patentability. See MPEP § 806.05.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention: .

a. Endoscope/microscope with arrangement shown in fig. 1;

b. Endoscope/microscope with arrangement shown in fig. 2;

c. Endoscope/microscope with arrangement shown in fig. 3;

d. Endoscope/microscope with arrangement shown in fig. 4;

e. Endoscope/microscope with arrangement shown in fig. 6;

f. Endoscope/microscope with arrangement shown in fig. 7;

g. Endoscope/microscope with arrangement shown in fig. 8;

h. Endoscope/microscope with arrangement shown in fig. 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,24,27 and 44 appear to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant

must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication should be directed to Mark Robinson at telephone number (703) 305-3506.

Mark Robinson
Patent Examiner
Art Unit 2872
4/10/01